



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/277,189 | 03/26/1999 | EDWARD G. MCLAUGHLIN | 048657-5001 | 3185 |

22922 7590 12/22/2004

REINHART BOERNER VAN DEUREN S.C.
ATTN: LINDA GABRIEL, DOCKET COORDINATOR
1000 NORTH WATER STREET
SUITE 2100
MILWAUKEE, WI 53202

EXAMINER

POINVIL, FRANTZY

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3628

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---|--|
| Office Action Summary | Application No. 09/277,189 | Applicant(s) MCLAUGHLIN ET AL. <i>ST</i> | |
| | Examiner Frantzy Poinvil | Art Unit 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on 09/22/2003, PROSECUTION IS HEREBY REOPENED.

The Examiner has found new prior art. The Examiner is obliged to apply the newly found prior art. Thus, the finality of the prior Office action has been withdrawn and a new rejection follows. The Examiner regrets the delayed process of the application. Accordingly, claims 1-30 remain pending in the application.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling (US Patent No. 5,963,925) in view of Krouse et al (US Patent No. 6,097,834).

As per claims 1 and 16, Kolling teaches a system and method for presenting an electronic bill or statement to a customer who has subscribed to receive electronic bills from a biller. See the abstract and column 12, lines 36-42. The system further comprises:

Allowing a customer to subscribe to a bill presentment system for receiving electronic-based (column 12, lines 36-42 and column 4, line 63 to column 5, line 16) of Kolling.

notifying a plurality of billers that said customer has subscribed to said bill presentment system, said billers including electronic-based billers (column 4, line 63 to column 5, line 16 of Kolling);

receiving at least one electronic bill for said customer from at least one of said billers (column 7, lines 25-57 of Kolling);

identifying the type of bill (is done using a template library. Also, different billers would send different bills and different types of bills for different customers) column 8, lines 52-62 and column 9, lines 28-64 of Kolling)

extracting billing information from said electronic image information wherein the billing information is extracted using a predefined template (see column 9, line 28 to column 10, line 21 and column 11, lines 43-55 of Kolling);

presenting said at least one electronic bill to said customer (column 13, lines 334-59 of Kolling).

Kolling does not specifically teach receiving paper bills for conversion to electronic bills. Thus, Kolling does not specifically teach the steps of:

receiving at least one paper bill for said customer from at least one of said billers;
identifying the contents of said paper bill;
scanning said at least one paper bill received for said customer to generate electronic image information; and validating the extracted billing information generated from said scanned paper bill.

As per these limitations the Examiner notes that transmitting or mailing paper bills to Kolling for further processing and presenting to a customer in an electronic format would have been obvious to one of ordinary skill in the art to do at the time of the invention. Nothing in Kolling prevents Kolling from accepting paper bills for conversion to electronic formats. A biller in the system of Kolling may not have the capability of electronically transmit their electronic bills to the system of Kolling for further processing by Kolling. Thus, transmitting paper bills to the system of Kolling would have been readily acceptable through the regular mail system.

In so doing, Kolling would have scanned the received paper bills, do further image processing and cleaning the scanned paper bills which would have then converted in an electronic format. The extracted steps would have also been done for indexing and record keeping purposes.

These steps are well known in the art of image processing and analysis of scanned financial documents. Since Kolling deals with electronic statements which are financial documents, an ordinary skill artisan would have turned to the teachings of Krouse et al. for these above noted teachings. Krouse et al teach a system and method for scanning a financial document. Image manipulation, data extraction and indexing are performed. See column 14,

lines 54-67 and column 10, lines 12-53 of Krouse et al. Krouse et al also disclose zone information for obtaining information from a financial document. See column 7, lines 33-67 of Krouse et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Krouse et al into the system of Kolling in order to facilitate the conversion of paper bills into an electronic format for presenting to a customer. The motivation would have been to encourage billers who are not yet ready to transmit electronic bills to the bill processors of Kolling to do so and also to facilitate the processing and/or conversion of paper bills to electronic bills.

As per claims 2 and 17 removing unnecessary material form the received paper bill is taught by Krouse et al. Kolling further teaches forwarding important documents from the received bill to the customer (see the abstract and column 4, lines 15-29); receiving a payment instruction form the customer to pay a bill, drafting a payment on an account for the customer account, and sending the payment to the biller that originated the bill (are taught on column 9, lines 13-28 of Kolling).

As per claims 3, 18 and 26, the combination of Kolling and Krouse does not explicitly teach drafting a payment comprises the step of printing a physical check on the account. The Examiner notes that such is well known in the art the time of the filing of the invention. Incorporating such a feature in the combination of Kolling and Krouse would have been obvious to one of ordinary skill in the art do in order to provide alternate forms of payment in the combined system.

As per claims 4, 19 and 27, printing a stored scanned image of a remittance stub is not explicitly taught by Kolling. Krouse et al disclose storing a scanned image of a remittance stub. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Krouse et al into Kolling in order to store a scanned image of a remittance stub for record keeping, reconciliation and management of the combined financial system.

As per claims 5-6, 20-21, the combined teaching of Kolling and Krouse et al discloses drafting a payment comprising the step of submitting an electronic payment (see column 9, lines 14-48 of Kolling and the abstract of Krouse et al.) using one of an automated clearing house network, an automated teller machine network, and a credit card network

As per claims 7 and 22, the combined teachings of Kolling and Krouse et al. are discussed above. Krouse et al disclose extracting billing information from the electronic image using optical character recognition wherein the billing information is extracted using a predefined template for the type of bill identified and extracting an image of the payment remittance stub. See column 7, lines 50-67 of Krouse et al. Kolling also discloses a plurality of templates for customers' bills. Note column 10, line 49 to column 10, line 21 of Kolling.

As per claims 8 and 23, presenting an electronic image of a paper bill upon receipt of a request from the customer is taught by Kolling. See the abstract of Kolling.

Claims 9 and 25 contain features addressed in claim 1. Claims 9 and 25 are therefore rejected under a similar rationale as applied to claim 1 above.

As per claim 10, Kolling discloses a biller identification for identifying a particular bill.

See column 10, lines 48-65 and column 9, lines 40-45 of Kolling.

As per claim 11, the combination of Kolling and Krouse does not explicitly teach drafting a payment comprises the step of printing a physical check on the account. The Examiner notes that such is well known in the art the time of the filing of the invention. Incorporating such a feature in the combination of Kolling and Krouse would have been obvious to one of ordinary skill in the art do in order to provide alternate forms of payment in the combined system.

As per claim 12, printing a stored scanned image of a remittance stub is not explicitly taught by Kolling. Krouse et al disclose storing a scanned image of a remittance stub. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Krouse et al into Kolling in order to store a scanned image of a remittance stub for record keeping, reconciliation and management of the combined financial system.

Each of claims 13 and 28 contains features recited in independent claims 1, 4, 5, 7 and 8, and therefore, applicant is directed to the rejection of claims 1, 4, 5, 7 and 8 above.

As per claims 14 and 29, see column 7, lines 54-62 of Krouse et al.

As per claims 15, 25 and 30, see column 7, lines 50-67 of Krouse et al.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.


The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326 for Before Final actions and (703) 87209327 for After Final actions.


Art Unit: 3628

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP

December 7, 2004


FRANZY POINVIL
PRIMARY EXAMINER
Au 3628


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800